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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,542	03/19/2004	Marc Ira Lipton	8285/679	7478
7590 06/02/2008 Peter C. Breen BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			EXAMINER LINDSEY, MATTHEW S	
			ART UNIT 2151	PAPER NUMBER
			MAIL DATE 06/02/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/804,542

**Applicant(s)**

LIPTON, MARC IRA

**Examiner**

MATTHEW S. LINDSEY

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-36 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 20-36 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 20-36 are pending in this application. Claims 29-31 are amended as filed on 1/24/2008.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 29-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

4. Claims 29-32 fail to place the invention squarely within one statutory class of invention. On pages 6-7, lines 19-21, 28-32 (page 6), 1-2 (page 7) of the instant specification, applicant has provided evidence that applicant intends the "computer readable medium" to include signals. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore these claims are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefor not a composition of matter.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**6. Claims 20-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Aravamudan et al. (US 6,301,609 B1).**

7. With respect to claim 20, Aravamudan discloses: "A method comprising: receiving a telephone call (Col. 7, lines 1-4, where a user utilizes a CPE to connect to a network, and the CPE may be a wired telephone, screen phone, or wireless cellular phone according to Col. 3, lines 28-35, and as such the communication services platform can receive a phone call); identifying a user making said telephone call (Col 7, lines 21-22, where a users' presence online is detected); detecting an online status of at least one member of a group associated with said user (Col. 7, lines 21-22, and 26-29, where a pending event can be detecting the status of selected buddies as identified by the user); and sending a message within said telephone call, said message indicating said online status of said at least one member of said group (Col. 7, lines 37-40)".

8. With respect to claim 25, Aravamudan discloses: "A method comprising: receiving a telephone call (Col. 7, lines 1-4, where a user utilizes a CPE to connect to a network, and the CPE may be a wired telephone, screen phone, or wireless cellular phone according to Col. 3, lines 28-35, and as such the communication services platform can receive a phone call); identifying a user making said telephone call (Col 7, lines 21-22, where a users' presence online is detected); receiving instructions to detect an online status of at least a first member and a second member associated with said user (Col. 7, lines 21-22, and 26-29, where a pending event can be detecting the status of selected buddies as identified by the user); detecting said first member of said group is online (Col. 7, line 29, where a first buddy can be online); detecting said second member of said group is off-line (Col. 7, line 29, where it is inherent that there will be a situation when out of two users the first will be online and the second will be offline); and sending a message within said telephone call, said message indicating online status of at least said first and second member of said group (Col. 7, lines 37-40)".

9. With respect to Claim 29, Aravamudan discloses: "A computer-readable medium comprising a set of instructions to direct a processor (Col. 12, lines 9-13) to perform acts of: receiving a telephone call (Col. 7, lines 1-4, where a user utilizes a CPE to connect to a network, and the CPE may be a wired telephone, screen phone, or wireless cellular phone according to Col. 3, lines 28-35, and as such the communication services platform can receive a phone call); identifying a user making said telephone call (Col 7, lines 21-22, where a users' presence online is detected); determining a

group of members associated with said user (Col. 7, line 29, specifically "selected buddies as identified by the user"); detecting an online status of at least one member of said group (Col. 7, lines 21-22, and 26-29, where a pending event can be detecting the status of selected buddies as identified by the user); and sending a message within said telephone call, said message indicating said online status of said at least one member of said group (Col. 7, lines 37-40)".

10. With respect to claim 33, Aravamudan discloses: "A method comprising: detecting an online status of a user (Col. 7, lines 21-22, and 26-29, where a pending event can be detecting the status of selected buddies as identified by the user); determining that a first member of a group associated with the user is off-line (Col. 7, line 29, where it is inherent the status of a first member of the group could be off-line); storing a notification message of said online status of said user in a storage device (Col. 6, lines 27-29); receiving a telephone call from said first member (Col. 7, lines 1-4, where a user utilizes a CPE to connect to a network, and the CPE may be a wired telephone, screen phone, or wireless cellular phone according to Col. 3, lines 28-35, and as such the communication services platform can receive a phone call); and sending a message within said telephone call, said message comprising said notification message stored in said storage device (Col. 7, lines 37-40)".

11. With respect to claims 21, 26, 30 and 35, Aravamudan discloses: "further comprising: receiving a password of said user (Col. 6, line 39, where a user chooses a

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password, and it is well known in the art that a username and password can be used to identify a user)".

12. With respect to claims 22 and 27, Aravamudan discloses: "further comprising: determining said group of members associated with said user (Col. 7, line 29, where the user identifies selected buddies)".

13. With respect to claims 23 and 31, Aravamudan discloses: "further comprising: receiving instructions to detect an online status of said at least one member of said group (Col. 7, line 29, where the pending event is status of selected buddies identified by the user, indicating the system received instructions from the user to perform this event)".

14. With respect to claims 24, 28, 32, and 36, Aravamudan discloses: "further comprising: wherein said message comprises an audio message" (Col. 3, lines 1-3, where the service provider can provide means for converting received data and communication mode and channel, and Col. 11, lines 38-41, where the user can choose the preferred delivery channel, specifically PSTN).

15. With respect to claim 34, Aravamudan discloses: "The method of Claim 33 further comprising: determining a user-initiated notification option is enabled (Col. 7, line 27, specifically "as identified by the user)").

### ***Response to Arguments***

16. Applicant's arguments see pg 5, II. Rejections Under 35 USC 101, filed 1/24/2008 have been fully considered but they are not persuasive. On pages 6-7, lines 19-21, 28-32 (page 6), 1-2 (page 7) of the instant specification, applicant has provided evidence that applicant intends the "computer readable medium" to include signals. As such the claims are drawn to a form of energy and are non statutory. Applicant is suggested to replace "computer readable medium" with "computer readable storage medium".

17. Applicant's arguments with respect to claims 20-36 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW S. LINDSEY whose telephone number is (571)270-3811. The examiner can normally be reached on Mon-Thurs 7:30-5, Fridays 7:30-1.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone



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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MSL

4/22/2008

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2151